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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,073	02/13/2002	William Glen Harter	A0000428-01-CFP	7569
28880	7590	06/25/2004	EXAMINER	
WARNER-LAMBERT COMPANY 2800 PLYMOUTH RD ANN ARBOR, MI 48105			TRUONG, TAMTHOM NGO	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/075,073

Applicant(s)

HARTER ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,3,6-10,13-24,33,42,43,46,47,53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,6,9,10,23,24,33,42,43,46,47,53 and 54 is/are rejected.
- 7) ☒ Claim(s) 7,8 and 13-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6-10-02</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's amendment of 04-12-04 has been considered. The claims have been amended to recite only the elected subject matter.

Claims 1, 4, 5, 11, 12, 25-32, 34-41, 44, 45, and 48-52 have been cancelled. Claims 53 and 54 have been added to recite the elected subject matter in the cancelled claim 1. No new matter is noted.

Pending claims are 2, 3, 6-10, 13-24, 33, 42, 43, 46, 47, 53, and 54.

The indicated allowability of claims 2, 3, 6-10, 13-24, 33, 42, 43, 46, 47 is withdrawn in view of the newly discovered reference(s) to those cited herein. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 3, 6, 9, 10, 23, 24, 33, 42, 43, 46, 47, 53, and 54 are rejected under 35

U.S.C. 102(b) as being anticipated by the following references:

- a. **Furuya et. al.** (US 5,817,819 cited on IDS): For example, see compounds # 26, 27, 28, 29 in Table 6 on column 59. The disclosed compounds are used to treat several hormone dependent diseases.
- b. **Furuya et. al.** (WO 95/28405, or WO 96/24597 cited on IDS): For example, see compounds # 3, 4, and 6-12 in the table on page 44 (WO'597). The disclosed compounds are used to treat several hormone dependent diseases.
- c. **Furuya et. al.** (WO 97/07119 cited on IDS): For example, see compounds # 1, 2(3), and 6-9 in the table on page 46. The disclosed compounds have endothelin receptor antagonistic action which treats various heart diseases (e.g., myocardial infarction, heart failure, atherosclerosis, cardiac hypertrophy, etc.).
- d. **Morimoto et. al.** (US 5,284,661 cited on IDS): For example, see compounds # 49, 50, and 52 in Table 10a on columns 35 and 36. The disclosed compounds are used as angiotensin II antagonists to treat hypertension, and heart diseases.
- e. **Morimoto et. al.** (EP 443,568 A1 cited on IDS): For example, see compounds # 34, 36, and 37 in Table 4a on page 18. The disclosed compounds are used as angiotensin II antagonists to treat hypertension, and heart diseases.

The disclosed compounds read on the compounds of formulae I, II, III, and XI with the following substituents:

- The ring having W is thieno (or X is -S-);
- $R^2$  is hydrogen or alkyl;
- $R^1$  is hydrogen, a (un)substituted alkyl, or (un)substituted  $(CH_2)_n$ aryl group;

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- $R^3$  is hydrogen or a (un)substituted alkyl group, or
- Ring W is substituted with A-B- $R^3$ ;
- A is  $-C(=O)-$ ; B is O;
- $R^3$  is hydrogen or an alkyl group;

Note, the proviso in claims 2, 6, 53, and 54 is not clear if both  $R^1$  and  $R^3$  cannot be hydrogen and alkyl groups at the same time, or if one of them can be hydrogen while the other is an alkyl group. Thus, the proviso has not completely excluded some of the compounds known in the art.

### ***Claim Objections***

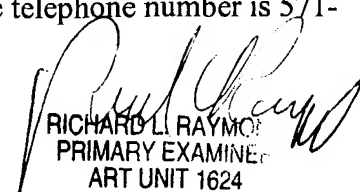
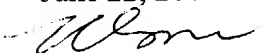
Claims 7, 8, 13-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The species recited in said claims are not disclosed in the cited references because they have the substituent of "*benzoic acid*", or "*methanesulfonyl-benzyl*".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (~10 am ~ 6:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at 571-272-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting SPE of 1624, at 571-272-0661.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

T. Truong  
June 22, 2004



RICHARD L. RAYMOND  
PRIMARY EXAMINER  
ART UNIT 1624